

REMARKS

**Reconsideration And Allowance
Are Respectfully Requested.**

Claims 53-63 are currently pending. Claims 1-52 were previously canceled. No new matter has been added. Previously presented claims 53-58 and 62-63 have been amended. No new claims have been added. Reconsideration is respectfully requested.

NEW OATH/DECLARATION REQUIREMENT

The requirement for a new or supplemental oath or declaration is deemed improper as the subject matter of the claims is clearly set forth in the parent application SN 08/308,097 from which the current application claims priority. The current claims may not quote the parent specification verbatim, but surely one of ordinary skill in the art would understand that "the creation of a cavity site from which a tissue sample has been removed during a biopsy" is inherent in the disclosure. The definition of the term "biopsy" in and of itself indicates that tissue has been removed and if tissue is removed what remains is a cavity where the tissue used to reside. The parent specification discloses removing tissue and marking the location. Regardless, the claims have been amended to use the broader term "location", which is the exact language used in the specification. The term "location" would include any cavity formed by the removal of tissue. Accordingly, the request for a supplemental oath/declaration is considered moot.

112 REJECTIONS

All of the 35 U.S.C. 112, first paragraph, rejections are deemed moot in view of the current amendment to the claims. As discussed above, the language regarding a cavity was inherent, but Applicant has amended the claims to use the broader term 'location' as explicitly set forth in the specification.

Further, and with regard to claims 56, 57, 62 and 63, the specification on page 9, lines 14-19 supports the claim that the marker can be made from a radiopaque material, which is what is now claimed.

102 REJECTIONS

Claims 58-63 stand rejected under 35 U.S.C. 102 (e) as being clearly anticipated by U.S. Patent No. 5,545,208 to Wolff et. al ('Wolff'). Applicants consider this rejection to be improper and respectfully request it be withdrawn.

Wolff discloses a prosthesis for insertion into a lumen to limit restenosis of the lumen. The prosthesis carries restenosis-limiting drugs which elute after the device is positioned in the lumen.

While Wolff's device is implantable within the body, that is all Wolff has in common with what is claimed. There is no disclosure in Wolff that it is capable or could be used as a breast biopsy marker.

There are numerous things which can be implanted into the human body. However, just because they are capable of implantation does not turn them into a biopsy marker. A hip prosthesis

is implanted into the body, but surely that does not mean it can function as a breast biopsy marker. The term "biopsy marker" must be given some weight. In fact, the U.S.P.T.O's own classification system has given the term "biopsy marker" weight, as it has created definitive subclasses in class 600 in which markers are to be searched and classified during examination.

A prosthesis with an inventive function of limiting restenosis as disclosed by Wolff is surely not capable of functioning as a biopsy marker. Restenosis is the reoccurrence of stenosis, the narrowing of a blood vessel, leading to restricted blood flow. Just like a hip prosthesis is not capable of being used as a breast biopsy marker, one of ordinary skill in the medical field would not use a restenosis limiting prosthesis as a breast biopsy marker.

It has now been shown the § 102 rejection is improper and it is respectfully requested that the rejection of claims 58-63 be withdrawn.

103 REJECTIONS

Claims 53-57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,161,034 to Burbank et al. ("Burbank") in view of Wolff. Applicants consider this rejection to be improper and respectfully request it be withdrawn.

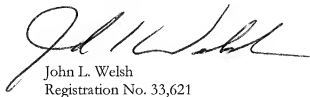
As previously indicated in a prior amendment, Burbank does not constitute prior art as it does not have a priority date prior to September 16, 1994, to which Applicants' claims are entitled.

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Amendment dated June 16, 2010
Reply to Office Action of March 16, 2010

It has now been shown the § 103 rejection is improper and it is respectfully requested that the rejection of claims 53-57 be withdrawn.

In view of the newly submitted amendment it is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number

Respectfully submitted,



John L. Welsh
Registration No. 33,621

Welsh & Flaxman LLC
2000 Duke Street, Suite 100
Alexandria, VA 22314
(703) 920-1122

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